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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/554,025

Applicant(s)

DORR, CHRISTOPH

Examiner

Ernesto Garcia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,13,14,16-18 and 20-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☒ Claim(s) 13,16,17 and 20-25 is/are allowed.

- 6) ☒ Claim(s) 11,14,18 and 26 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the British patent, 1,260,144 (see marked-up attachment provided in the previous Office action).

Regarding claim 11, the British patent discloses in Figure 3 a ball-and-socket joint having a joint pin **10**, a joint housing **18**, a bearing shell **78**, and a metal ring **A7**. The joint pin **10** is provided with a joint ball **16**. The bearing shell **78** is inserted into the joint housing **18**. The metal ring **A7** is embedded in the joint housing **18**, i.e., the ring is fixed firmly in a surrounding mass, the housing. The metal ring **A7** has a radially inwardly bent end segment **76** located in an area of an opening **A1** in the joint housing **18**. An inside diameter **A5** of a cylindrical center part of the metal ring **A7** corresponds to an outside diameter of the bearing shell **78**. However, the British patent fails to disclose the joint housing **18** being a plastic joint housing. Applicant is advised that,

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within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the joint housing out of plastic therefore making a plastic joint housing. *In re Leshin*, 125 USPQ 416.

Regarding claim 14, the cylindrical center part ends in an area of an equator of the joint ball **16**.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the British patent, 1,260,144, in view of Kindel, 3,530,495.

Regarding claim 18, the British patent, as modified above, fails to disclose the joint housing **18** provided with a ring groove in the area of the opening **A1**. Kindel teaches in Figure 1a joint housing **1** provided with a ring groove (unmarked) in an area of an opening **1b** to alternatively attach a sealing bellows **5** to the joint housing **1**. Therefore, as taught by Kindel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a ring groove in an area of an opening of a housing to alternatively attach a sealing bellows to the housing.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the British patent, 1,260,144, as applied to claim 11 above, and further in view of the Songer, 3,574,368.

Regarding claim 26, the British patent '144, as discussed above, discloses the radially inwardly bent end segment **76** secures the bearing shell **78** in the joint housing **18**. However, the British patent '144 fails to disclose the metal ring **A7** protruding outwardly of the plastic joint housing **18** such that the radially inwardly bent end segment **76** is spaced away from the joint housing **18** in the area of the opening **A1** of the joint housing **18**. Songer teaches a metal ring **17** protruding outwardly of a joint housing **3** such that a radially inwardly bent end segment **18** is spaced away from the joint housing **3** in an area of an opening of the joint housing **3**. It would have been an obvious matter of design choice to protrude the metal ring outwardly such that the radially inwardly bent end segment is spaced away from the joint housing, since applicant has not disclosed that bend end segment being spaced away from the joint housing solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a metal ring not protruded outwardly of a joint housing in an area of an opening of a joint housing.

Allowable Subject Matter

Claims 13, 16, 17, 20-25 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 24, the prior art of record does not disclose or suggest a ball-and-socket joint comprising a metal ring having a radially outwardly angled flange that is extrusion-coated with material of a joint housing;

regarding claim 13, this claim depends from claim 24;

regarding claim 25, the prior art of record does not disclose or suggest a ball-and-socket joint comprising a bearing shell including a pin-side area provided with slits; Morin disclose a ball-and-socket joint comprising the bearing shell as claimed, but there is no reason to modify or combine the British patent with Morin;

regarding claims 16 and 17, these claims depend from claim 15; and,

regarding claim 20, the prior art of record does not disclose or suggest a ball-and-socket joint comprising a metal ring having a cylindrical portion protruding from an opening of a joining housing and forming a passage receiving a bearing shell.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for making the joint housing out of plastic is found in the knowledge generally available to one of ordinary skill in the art.

Applicant has argued that the British patent fails to teach the metal ring "embedded" in the joint housing. By definition, the term embedded means to be fixed firmly in a surrounding mass. In this instance, the surround mass is the housing. It is clear from the figures that the ring is fixed firmly. Applicant is reminded that claims in a pending application should be given their broadest reasonable interpretation. In *re Pearson*, 181 USPQ 641 (CCPA 1974).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sleeve (the ring) is fixed within a recess of a body of the housing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, applicant has argued that the British patent fails to teach or suggest the metal ring to positively lock the bearing shell within the joint housing. Applicant is

reminded that a recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the metal ring is capable of positively locking the bearing shell within the joint housing.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

February 19, 2003